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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,090	11/20/2003	Taku Kodama	245691US2	7016
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER	
			DANG, DUY M	
			ART UNIT	PAPER NUMBER
			2624	
			NOTIFICATION DATE	DELIVERY MODE
			02/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/717,090

Applicant(s)

KODAMA ET AL.

Examiner

Duy M. Dang

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-205 is/are pending in the application.
- 4a) Of the above claim(s) 13-19, 30-35 and 40-205 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 20-29 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/24/04, 2/2/05, 11/29/05, 1/10/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species I, Claims 2-12, 21-29, and 36-39, in the reply filed on 11/19/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, claims 13-19 and 30-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II, there being no allowable generic or linking claim.
2. The examination on the merit of claims 1-12, 20-29 and 36-39 are presented in this Office action.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-12, 20-29 and 36-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is insufficient antecedent basis for the limitation of "the same" recited in claim 1 line 4 and claim 20 line 5. Likewise, dependent claims 2-12, 21-29 and 36-39 are also rejected for the same reasons.

Regarding claim 28, the phrase "such as" recited at lines 4 and 9 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Furthermore, the phrase "or so" recited at line 5 and last line renders the claim(s) indefinite because the claim includes elements not actually disclosed (those encompassed by "or so"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 36-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In this case, claims 36-37 are directed to a "program" which is not process, machine, manufacture, or composition of matter as set forth in section 101. Therefore, claims 36-37 fail to comply with the requirement as set forth in section 101. See MPEP (Published September 2007) 2106(IV) and 2106.01.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 20-27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by

Maeno et al (US Pub. No. 2005/0129268 A1. Referred as Maeno hereinafter).

Regarding claim 1, Maeno teaches an image processing apparatus (see figure 5A) comprising:

a code stream generating part (i.e., encode depicted at 286 of figure 5A and described at paragraph [0078])) converting image data into two-dimensional wavelet coefficients (i.e., discrete wavelet transform or DWT depicted at 300 of figure 5A and described at paragraph [0078]), quantizing the same (i.e., quantizer depicted at 302 of figure 5A and described at paragraph [0079]) and coding the quantization result so as to compress the image data and generate a code stream (i.e., encoder depicted at 304 of figure 5A and described at paragraph [0079]);

an additional information creating part creating additional information concerning the image data (i.e., watermarking unit depicted at 308 of figure 5A and described at paragraph [0080]. This interpretation is consistent with applicant's disclosed paragraph [0069] or page 27 lines 11-12 of the specification, which states "additional information comprises); and

an additional information embedding part embedding the thus-created additional information into the code stream as a code in an off-rule zone which is not decoded by a JPEG 2000 standard rule (i.e., format unit depicted at 306 of figure 5A for embedding watermark to

codestream output by the encoder 306 as described at paragraph [[0081]. Note that watermarking information i.e., signature value Si, output from watermarking unit 308 are placed in the header of the encoded image data and this header corresponds to the so called "off-rule zone" within the broadest reasonable interpretation (See In re Tanaka et al., 193 USPQ, (CCPA) 1977). Furthermore, this Si is not decoded by JPEG 2000 standard rule because Si is not the JPEG 2000 codestream output at encoder 304 as illustrated in figures 5A and 5E (Note that the Si is extracted by payload extractor 330 then is transmitted to verifier 348 whereas JPEG 2000 compressed codestream is decoded by decoders 332, 334 and/or 336 according to paragraph [0086] and this decoder functions as a JPEG 2000 decoder)).

The advanced statement as applied to claim 1 above is incorporated herein. With regard to claim 20, it is noted that this claim recites an inversing function as called for in claim 1. Thus, claim 20 is also rejected for the same reasons as applied to claim 1 above in combination with figure 5E which illustrates an inversion function of the figure 5A representation.

The advanced statement as applied to claims 1 and 20 above are incorporated hereinafter. Maeno further teaches additional information creating part (see watermarking unit depicted at 308 of figure 5A and described at paragraph [0080]) as required by claim 21; additional information processing part (see verifier 348 of figure 5E which processes Si, pi and vi output from payload extractor 330) as required by claims 22-27 and 29.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeno.

The advanced statement as with regard to Maeno above is incorporated hereinafter.

Maeno does not explicitly teach the use of a program as required by claim 36 and a computer readable recording medium as required by claim 38. However, such program and computer readable recording medium are well known and widely used in the art (Official Notice). The motivation for using such program and medium is because it is cheap, easier to modify, less environment effect, robust and efficient. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such well-known features in combination with Maeno for that reasons.

Likewise, claims 37 and 39 are also rejected for the same reasons as set forth in claims 36 and 38 above.

Allowable Subject Matter

12. Claims 2-12 and 28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter:

The cited prior art does not teach or suggest the claimed features as recited in claims 2 and 28. Likewise, claims 3-12 depend from claim 2 and thus are allowable for the same reasons.


Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
15. References listed on PTO-892 teach the image compression and watermark embedding.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dmd
1/08


DUY M. DANG
PRIMARY EXAMINER